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EXAMINER

BLANCO, JAVIER G

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BOSTON SCIENTIFIC SCIMED, INC.

Appeal 2008-2116
Application 09/387,696
Technology Center 3700

Decided: November 5, 2008

Before FRED E. McKELVEY, *Senior Administrative Patent Judge*, and
JAMESON LEE and RICHARD TORCZON, *Administrative Patent Judges*.

TORCZON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Claims 54 and 57 stand rejected under 35 U.S.C. 102(b) (Ans. at 3-4).
Claim 58 stands rejected under 35 U.S.C. 103(a) (Ans. at 4). The appellant,
Boston Scientific Scimed, Inc. (Boston Scientific), seeks review under
35 U.S.C. 134. We REVERSE.

The examiner relied upon the following prior art in rejecting the claims (Ans. at 3):

Song	WO 92/06734 A1	30 April 1992
Dereume et al. (Dereume)	5,639,278	17 June 1997

The examiner held that Song anticipated claims 54 and 57 (Ans. at 3). The examiner also held that the subject matter of claim 58 would have been obvious in view of Song and Dereume (Ans. at 4).

THE CLAIMS

Boston Scientific argues the rejection of independent claims 54 and 57 together (Br. at 5). Boston Scientific argues the rejection of claim 58, which depends from claim 54, separately (Br. at 7). All three claims contain the contested limitation (Br. at 9):

a plurality of discrete structural wires or filaments joined together to form said prosthesis, said wires or filaments each having one or more corrugated portions and at least some of said wires or filaments having one or more generally straightened extension portions[.]

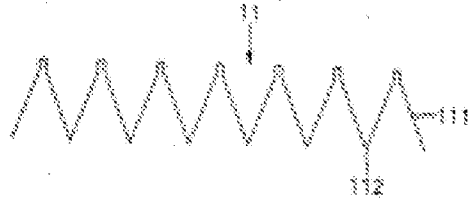
This limitation to define a set of wires or filaments (hereafter "wires") in which all of the wires have at least one corrugated portion and at least one of the wires also has at least one straightened extension portion. Since the wires with the generally straightened extension portions are a subset of the corrugated wires, this subset of wires must have both corrugations and straightened extensions. Since the straightened extensions are set out as a separate limitation, they are not part of the corrugations.

FINDINGS OF FACT

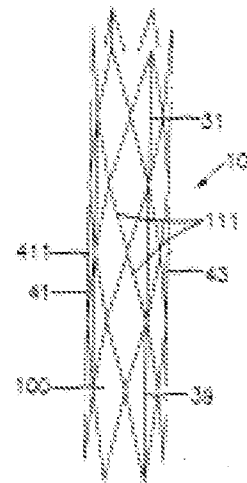
1. Song describes a self-expanding endovascular stent (Song at 3:3-7).

2. The stent is a cylinder formed from a closed, zigzag configuration of unit structures (Song at 3:11-19).

3. Song FIG. 1 (shown right) illustrates a zigzag-configured unit structure 11 with straight sections 111 and bends 112 (Song at 4:6-8).



4. Song FIG. 2 (shown right) illustrates an embodiment of the invention (Song at 4:9-11), which is a stent with a frame 10 composed of interlocked, zigzagging unit structures with straight sections 111 (Song at 5:17-23) and connecting members 31, 39 (Song at 6:2-4).



5. Song's connecting members 31, 39 extend between and tie together the unit structures (Song at 6:4-7), and appear to be straight.

6. Song's zigzag unit structures 11 and connecting members 31, 39 are not the same wires.

7. Song does not anticipate Boston Scientific's appealed claims.

ANALYSIS

Anticipation

The rejection is based on the following construction of the contested limitation (Ans. at 5):

The claim language does not require the "generally straightened extension portions" to be part of the same discrete wires. Connecting members 31, 33, 35, and 37 are therefore "extension portions".

As explained above, this construction is impermissibly broad since it overlooks the structure of the contested limitation, which makes the wires with straightened extensions a subset of the corrugated wires. Thus, contrary to the examiner's construction, the wires with the straightened portions must indeed be part of the same wires. The examiner has not relied on alternative disclosure in Song that would have anticipated the contested limitation when properly construed.

The examiner has not shown claims 54 and 57 to have been anticipated.

Obviousness

Boston Scientific relies on the insufficiency of the anticipation rejection based on Song to overcome the obviousness rejection for dependent claim 58 (Br. at 7). Since claim 58 depends from claim 54, it too incorporates the contested limitation. As discussed above, Song does not meet the contested limitation.

The examiner has not indicated where in the Dereume reference the contested limitation is disclosed (Ans. at 4-5). Moreover, the examiner has not provided an alternative basis for modifying the teachings of Dereume and Song to attain the subject matter of claim 58. Consequently, the examiner has not shown that the prior art teaches or suggests the contested limitation, when it is properly construed.

Appeal 2008-2116
Application 09/387,696

CONCLUSION

The rejections on appeal are —

REVERSED

MAT

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